

THIS DECISION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: 3/9/05

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Coverall North America, Inc.

v.

Cover-All, Inc.

Opposition No. 91118366  
to application Serial No. 75434680  
filed on February 17, 1998

Michael A. Grow, Christopher Grigorian of Arent Fox PLLC for  
Coverall North America, Inc.

Thomas I. Rozsa of Rozsa & Chen for Cover-All, Inc.

Before Quinn, Chapman and Bucher, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Cover-All, Inc. to register  
the mark COVER-ALL for "installation of floor coverings."<sup>1</sup>

Coverall North America, Inc. opposed registration on  
the ground of likelihood of confusion pursuant to Section  
2(d) of the Trademark Act. Opposer alleged that applicant's  
mark, when used in connection with applicant's services, so  
resembles opposer's previously used and registered COVERALL

<sup>1</sup> Application Serial No. 75434680, filed February 17, 1998,  
alleging first use anywhere and first use in commerce on January  
2, 1996.

marks for maintenance and cleaning services, as to be likely to cause confusion. Opposer has pleaded the following previously registered marks: COVERALL for "maintenance and cleaning of offices and commercial buildings";<sup>2</sup> COVERALL CLEANING CONCEPTS for "maintenance and cleaning of offices and other commercial buildings";<sup>3</sup>



for "maintenance and cleaning of offices and commercial buildings";<sup>4</sup>



for "maintenance and cleaning of offices and commercial buildings";<sup>5</sup> SINGLE SOURCE BY COVERALL for "arranging for

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<sup>2</sup> Registration No. 2178521, issued August 4, 1998; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>3</sup> Registration No. 2075333, issued July 1, 1997; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>4</sup> Registration No. 2252554, issued June 15, 1999. The word "cleaning" is disclaimed apart from the mark.

<sup>5</sup> Registration No. 2337703, issued April 4, 2000. The word "cleaning" is disclaimed apart from the mark. The stippling shown in the drawing is for shading purposes only and is not intended to indicate color.

repair and maintenance services, namely, janitorial cleaning, pressure cleaning, pest control, lawn maintenance, painting, carpentry, drywall, parking lot maintenance, snow removal, fire and flood restoration, and HVAC, duct and filter service";<sup>6</sup> and



for "cleaning preparations, namely floor cleaners; commercial floor maintenance services; and application of specialty chemicals to granite, marble, ceramic and other surfaces."<sup>7</sup>

In addition to the likelihood of confusion claim, opposer also pleaded that applicant's mark falsely suggests a connection with opposer or its related companies pursuant to Section 2(a) of the Trademark Act.

Applicant, in its answer, denied the salient allegations in the notice of opposition. Applicant further set forth several allegations captioned as "affirmative defenses."

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<sup>6</sup> Registration No. 2533774, issued January 29, 2002.

<sup>7</sup> Registration No. 2718891, issued May 27, 2003. The words "floorsystems" and "division" are disclaimed apart from the mark. The lining is a feature of the mark and does not indicate color. The registration includes the following description: "The mark consists of a shield with three footprints inside the shield."

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by both parties; status and title copies of opposer's pleaded registrations, copies of third-party registrations, portions of a discovery deposition and related exhibits, and applicant's responses to certain of opposer's interrogatories, all introduced by way of opposer's notices of reliance; and opposer's responses (original and amended) to applicant's interrogatories and request for production, made of record by applicant's notice of reliance. Both parties filed briefs.<sup>8</sup> An oral hearing was not requested.

#### **Evidentiary Objections**

Opposer objected to certain portions of applicant's trial testimony on the ground that these portions contain inadmissible hearsay. In each of the nine subject depositions, the witness was asked whether he/she ever received telephone calls wherein the caller had confused

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<sup>8</sup> Opposer's motion to extend its time to file a reply brief, to which applicant consented, is granted. The reply brief was timely filed.

Opposer, in its briefs, has made references to and relied upon prior Board opinions marked, as is the present opinion, "This disposition is not citable as precedent of the TTAB." Decisions that are so designated are not citable authority and will not be considered by the Board. Opposer should refrain in the future from citation to "unpublished" Board opinions. See *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895, 1897 n. 2 (TTAB 2001); and *In re Polo International Inc.*, 51 USPQ2d 1061, 1063 n. 3 (TTAB 1999). See generally TBMP §§101.03 and 1203.02(f) (2d ed. rev. 2004).

applicant with opposer, or whether any employee of applicant ever informed the witness that the employee had received telephone calls from someone asking for opposer. In each instance, the witness testified that he/she had not received any such calls nor had any employee informed him/her that the employee had received any misdirected calls.

Applicant, for its part, objected to certain portions of opposer's trial testimony on the ground of inadmissible hearsay. In each of the portions of eight depositions objected to by applicant, the witness was asked if he/she ever received telephone calls wherein the caller had confused opposer with applicant and, in each case, the witness testified that he/she had received such calls.

Each party argues that the subject testimony is relevant, of course, to the nature and extent of any actual confusion. Opposer relies on its testimony to show that there have been instances of actual confusion, while applicant relies on its testimony to show the absence of any actual confusion.

Hearsay is an out-of-court statement offered to prove the truth of the matter asserted. Fed. R. Evid. 801(c). Courts have responded to the hearsay objection in varying ways. See generally, J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 23:15 (4<sup>th</sup> ed. 2004).

The parties' respective objections are overruled, and we have considered each party's testimony in the present case. Opposer's testimony is not hearsay for it is accepted not for the truth of the statements made by the non-witnesses to opposer's deponents or the reasons therefor, but rather for the fact that the statements referred to in their testimony were, in fact, made to them. In a similar fashion, applicant's witnesses' statements of what others told them, that is, that no one has asked whether opposer and applicant were related, is not hearsay. See Toys "R" Us, Inc. v. Lamps R Us, 219 USPQ 340, 346 (TTAB 1983); and Finance Co. of America Corp., 205 USPQ 1016, 1035 (TTAB 1979).

Although the testimony is admissible, the probative value is discussed infra.

#### **The Parties**

Opposer has been engaged in the commercial cleaning business since 1982. Opposer's cleaning and janitorial services include floor care services such as vacuuming, dust mopping, stripping and waxing, buffing, shampooing, deep cleaning and other carpet and hard floor services. The services are rendered through a nationwide network of franchisees. According to Marci Kleinsasser, opposer's director of marketing, opposer has grown into one of the world's largest commercial cleaning franchises, with over

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7,000 franchise owners (and 85 regional support centers) providing services to more than 22,000 accounts. Account types include commercial office buildings, retail stores, hospitals and medical offices, government buildings, warehouses, and the common areas of apartment and condominium buildings. Revenues in 2002 were approximately \$200 million. Opposer promotes its services both nationally and locally through television and radio, the Internet, magazines, newspapers, brochures, Yellow Pages directories, and appearances at trade shows. Advertising expenditures in 2002 exceeded \$2.2 million. Opposer also has been the beneficiary of unsolicited favorable publicity, and has been identified in recent years as one of the country's top 500 franchises (ranked #10 by Entrepreneur Magazine).

Applicant has been engaged, since 1996, in the installation of flooring and flooring products, such as carpet, wood, vinyl, ceramic, and tile. These installation services are rendered to residential customers through large chain retailers like Home Depot, Sears and Costco. The services are marketed through brochures and business cards, listings in the Yellow Pages and the Internet. Applicant's advertising expenditures in 1996 and 1997 were approximately \$7,200 and \$9,500, respectively.

**Priority**

In view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide herein is likelihood of confusion (see discussion regarding mootness of Section 2(a) claim, infra).

**Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In *re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These, and other du Pont factors deemed pertinent in the proceeding now before us, are discussed below.

**The Marks**

Opposer's typed mark COVERALL, of all of opposer's pleaded marks, is closest to applicant's typed mark COVERALL. Opposer owns prior rights in the mark COVERALL standing alone, both by virtue of its prior use and prior



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registration. This mark is virtually identical in appearance to applicant's mark COVER-ALL, the only difference being a hyphen in applicant's mark. The marks are absolutely identical in sound. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

As to meaning, the marks COVERALL and COVER-ALL are arbitrary and distinctive, although they convey slightly different connotations. Both are somewhat suggestive, opposer's mark suggesting that its services cover all facets of cleaning and maintenance of offices and commercial buildings, and applicant's mark being suggestive of its installation of all types of floor coverings.

The virtual identity in the marks' appearance and the identity in sound outweigh any slight difference in connotation. As to overall commercial impression, the marks convey essentially the same impression.

Further, applicant's mark is similar to each of opposer's other COVERALL marks. Although each of these marks includes other matter, the dominant portion of the marks registered in Registration Nos. 2075333, 2252554 and 2337703 is COVERALL. In opposer's typed mark COVERALL CLEANING CONCEPTS, the first word in the mark is the one most likely to be remembered by purchasers, and the term COVERALL will likely be used in calling for the services.

Opposer's logo marks are dominated by the term COVERALL; as shown in the drawings, the COVERALL portion is prominently displayed. In the logo marks, the literal portion COVERALL CLEANING CONCEPTS dominates over the design features, and, in turn, the literal portion is dominated by COVERALL. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); and *Inter-State Oil Co., Inc. v. Questor Corp.*, 209 USPQ 583 (TTAB 1980). In comparing these marks with applicant's mark, we must consider, of course, the marks in their entirety. In doing so, however, there is nothing improper in according more weight to the suggestive, distinctive literal element of these marks, namely the term COVERALL. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000); and *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In comparing applicant's mark to opposer's mark SINGLE SOURCE BY COVERALL shown in Registration No. 2533774, we find that the virtual identity between COVERALL and COVERALL outweighs the differences between these two marks. In considering likelihood of confusion between these marks, we also are mindful of the fame of the mark COVERALL (see discussion, infra).

Lastly, we turn to opposer's mark shown in Registration No. 2718891. Clearly, the AEGIS portion thereof dominates this logo mark. Again, however, in considering this mark,

we are mindful of the fame of COVERALL. Although we find that this mark and applicant's mark are sufficiently similar for purposes of likelihood of confusion, we readily concede that this mark is least close to applicant's mark in terms of overall commercial impression.

In attempting to distinguish the marks, applicant presses the point that opposer's COVERALL mark and applicant's mark, as actually used in commerce, often appear with other wording. In this connection, applicant points to advertisements of record showing that opposer uses "COVERALL Cleaning Concepts" while applicant utilizes "COVER-ALL Flooring Services. Sales. Installation." Applicant's point is irrelevant for purposes of our likelihood of confusion analysis in that the additional words used by applicant do not appear in the drawing of the mark showing the mark sought to be registered. It is the mark shown in the drawing that must be compared to opposer's marks. See *Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990), citing *Frances Denney v. Elizabeth Arden Sales Corp.*, 263 F.2d 347, 120 USPQ 480, 481 (CCPA 1959).

Opposer, in addition to its other marks, has established prior rights in the mark COVERALL standing alone. Thus, the critical comparison for us to make in the present case is to compare applicant's mark to the mark of

opposer that is closest to it, namely, COVERALL versus COVER-ALL.

The facts that COVERALL and COVER-ALL are identical in sound and virtually identical in appearance and overall commercial impression "weighs heavily against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

### **The Services**

Applicant's argument that its installation of floor coverings services are different from opposer's commercial maintenance and janitorial services is at the center of its contention that confusion is unlikely to occur between the marks COVERALL and COVER-ALL.

In addition to its maintenance, cleaning and janitorial services, opposer sells floor cleaners. However, we have focused our attention, as have the parties, on the services rendered by each. See Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) [finding of likelihood of confusion may be based on relatedness of any one item in the involved identifications of goods/services].

With respect to the services, it is well established that the services of the parties need not be similar or competitive, or even that they are offered through the same channels of trade, to support a holding of likelihood of

confusion. It is sufficient that the respective services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the services, but rather whether there is a likelihood of confusion as to the source of the services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

The nature and scope of a party's services must be determined on the basis of the services recited in the application and/or registration. See, e.g., *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In comparing the services, we initially note that where virtually identical marks are involved, as is the case here, the lesser the degree of similarity between the parties'

services that is required to support a finding of likelihood of confusion. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993); Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002); and In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001). See generally 3 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2004).

Opposer's recitations of services encompass the maintenance and cleaning of floors and floor coverings. Moreover, the record shows that opposer's maintenance, cleaning and janitorial services are comprehensive in nature, and include floor care services. These services include stripping, waxing, sweeping, carpet shampooing and vacuuming. Ms. Kleinsasser testified that opposer invests substantial resources in training programs for its employees and franchisees. An element of their training relates to specialized skills in caring for carpets and floors. Opposer's "Hard Floor Care Certification Program" involves training in buffing, stripping and waxing of such floors, and the "Carpet Cleaning Certification Program" provides training in techniques and use of carpet cleaning equipment and chemicals.

Opposer also offers a non-slip floor treatment service through its Aegis Floorsystems division. This treatment removes surface particles of the silica sand in floor tiles,

thereby providing improved traction on the floor. The treatment is designed to reduce the number of slip-and-fall accidents, and it has been marketed primarily to fast-food franchises. According to Thomas Clark, the director of operations of this division, this treatment is an alternative to floor covering replacement and competes directly with the types of services offered by applicant. Mr. Clark testified that customers of this service made a specific choice between treating their existing floors and replacing the floors.

Although the cleaning and maintenance of floors and floor coverings on the one hand, and the installation of floor coverings on the other, are specifically different services, we find, based on the record before us, that the parties' services are commercially related. The services are related to the extent that a prospective purchaser may make a choice to maintain existing flooring (using opposer's services) or to install new flooring (using applicant's services).

Applicant installs the same types of floor coverings that opposer cleans and maintains. In finding that the parties' services are related, we considered the several third-party registrations covering both floor cleaning and maintenance services and carpet/floor installation services. Third-party registrations, which individually cover

different goods and/or services and which are based on use in commerce, serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

The relatedness of the parties' services weighs in opposer's favor.

### **Trade Channels**

The evidence of record reveals that opposer's services are rendered to commercial accounts, and this trade channel is reflected in the recitations of services in the pleaded registrations. The record shows that opposer's accounts include residential apartments and condominiums where it cleans common areas (including floors and carpets), but not the individual units. The record also reveals that applicant's services are rendered primarily to residential customers. In saying this, however, it is important to note that applicant has installed, in the past, floors and floor coverings for commercial customers. Although applicant has not focused on the commercial market, Gad Leshem, applicant's chief executive officer and president, testified that "I'm providing installation of flooring services and it will be open to whoever needs my services." [12/16/03 dep., p. 56]. Indeed, Mr. Leshem identified restaurants,



hospitals and the armed services branches of the federal government as prior customers.

As indicated above in discussing the similarity between the parties' services, applicant's services, as identified in the involved application, are not limited to residential use or to any other trade channel. Where the services in an involved application or registration are broadly described and there are no limitations in the identification of services as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the identification encompasses all services of the nature and type described, that the identified services are offered through all channels of trade that would be normal therefor, and that the services would be purchased by all of the usual potential customers. Thus, here, in the absence of any limitation, we must presume that applicant's services are rendered through all reasonable channels of trade, including both residential and commercial markets. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989); and *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984). In point of fact, as noted above, applicant has rendered its services to commercial customers. Accordingly, the trade channels overlap in the commercial arena.

**Conditions of Sale and Classes of Purchasers**

As indicated earlier, applicant points to the evidence of record in an attempt to distinguish the customers for its services (homeowners) from opposer's customers (building managers and commercial property owners). As was the case with trade channels, however, applicant's identification of services similarly does not include any limitations on purchasers for its services. Thus, we must presume that all potential purchasers, including both residential homeowners as well as commercial accounts, buy the floor installation services. In light of this presumption, there is an overlap in the classes of purchasers for the services.

There is competition between the parties and an overlap in customers in that, as noted earlier, a customer may decide either to replace a floor covering (using applicant's services) or to refurbish an existing floor (using opposer's services).

We recognize that the respective services may be costly and may require an informed purchasing decision. Nonetheless, given the virtual identity between the marks COVERALL and COVER-ALL, and the relatedness of the services rendered thereunder, even a discriminating purchaser would not be immune from confusion. In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

Fame

The fifth du Pont factor requires us to consider evidence of the fame of opposer's marks and, if established, fame plays a "dominant" role in determining likelihood of confusion. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As the Federal Circuit stated in *Bose Corp. v. QSC Audio Products Inc.*, supra at 1305:

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the duPont factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark...casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

The record establishes that opposer has enjoyed considerable success with its services (annual sales exceeding \$200 million), and that its marks have been nationally promoted (annual advertising costs exceeding \$2.2 million). Opposer is one of the most successful franchises

in the country according to printed publications in the field. In the face of this evidence, applicant essentially conceded the fame of opposer's COVERALL mark, with the caveat that this fame is confined "strictly and solely for use in conjunction with providing janitorial and cleaning services and not for anything else." (Brief, p. 38). Applicant emphasizes its point that "[o]pposer's fame is strictly and solely [confined to] the providing of janitorial and cleaning services through its franchisees to specific commercial buildings" and that "[t]here is no fame and no brand recognition whatsoever of Opposer's mark for the installation of flooring services of any kind whatsoever and no brand recognition and fame of the Opposer's mark for use in conjunction with providing services of any type to consumers in their homes." Id.

Although applicant attempts to limit the fame of opposer's COVERALL mark, this attempt impermissibly undercuts the legal standard of protection for famous marks. Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. The fame of a mark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product or service under a famous name. *Recot Inc. v. M.C. Becton*, supra at 1897.

Fame for confusion purposes arises as long as a significant portion of the relevant consuming public recognizes the mark as a source indicator. The proper legal standard for evaluating the fame of a mark under the fifth du Pont factor is the class of customers and potential consumers of the service, and not the general public. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, \_\_\_F.3d\_\_\_, 73 USPQ2d 1689 (Fed. Cir. 2005). As discussed above, the customers for the parties' respective services overlap and, thus, the fame of opposer's COVERALL mark plays an important role in this case.

In response to the type of argument set forth by applicant herein, our primary reviewing court has stated that a famous mark "can never be 'of little consequence'" and instructed:

This reasoning applies with equal force when evaluating the likelihood of confusion between marks that are used with goods that are not closely related, because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products. Indeed, it is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for, as the present case illustrates, the lure of undercutting or discounting the fame of a mark is especially seductive. See *Recot*, slip op. at 19 ("It is applicant's position that opposer's marks are famous for a variety of human food products, but that the fame of opposer's marks does not extend beyond that field...."). Accordingly, we hold

that the fame of the mark must always be accorded full weight when determining the likelihood of confusion. When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a "long shadow which competitors must avoid." [citations omitted].

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The Board also erred when it distinguished this court's precedent on the ground that our prior cases concerned products that were identical or closely related. Indeed, this court and its predecessor court have consistently stated that the fame of the mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods. [citations omitted].

Recot Inc. v. M.C. Becton, supra at 1897-98.

Accordingly, we have accorded the conceded fame of opposer's COVERALL mark for cleaning and janitorial services its full measure of weight in our likelihood of confusion analysis. As we found above, the services herein are related; but even if we had been persuaded by applicant's contention that the services are not related, the fame of opposer's COVERALL mark would still weigh heavily in opposer's favor.

### **Third-Party Use**

In connection with the strength of opposer's COVERALL mark, we also note that the record is devoid of evidence of

any third-party uses or registrations of the same or similar marks for similar or related services.

**Actual Confusion**

As discussed above in ruling on the parties' evidentiary objections, each party introduced testimony bearing on this factor. Opposer took the testimony of individuals (employees and franchisees of opposer) who testified about their receipt of misdirected phone calls, and one misdirected written correspondence. Applicant countered with the testimony of its employees who testified that they neither had received any misdirected phone calls, nor were aware of any instance where anyone confused applicant with opposer relative to the source of the respective services.

Convincing evidence of significant actual confusion occurring under actual marketplace conditions is strong proof of a likelihood of confusion. In the present case, although the evidence of actual confusion (or the lack thereof) is admissible, we have given it limited probative value on the issue of likelihood of confusion.

We have considered opposer's evidence to the extent that it shows that the calls did occur and were misdirected to opposer. In the absence of corroborating evidence about the callers, however, we are reluctant to place significant weight on this evidence. Had the callers themselves been

identified and made available for cross-examination, they could have explained their reasons for their questions as to the affiliation between opposer and applicant. While opposer's witnesses testified, not surprisingly, that the stated reason for the callers' confusion was the similarity between the marks and the services rendered thereunder, we would prefer to hear it from the callers themselves.

Thus, we have accorded only minimal weight to the parties' evidence on this factor. In any event, evidence of actual confusion is not essential to proving a case of likelihood of confusion.<sup>9</sup> *Giant Food, Inc. v. Nation's Foodservice, Inc.*, supra. Simply put, this du Pont factor is not critical in our analysis of the merits in this case.

#### **Other Issues**

Applicant has taken opposer to task for its failure to undertake a trademark confusion survey to gauge the subjective reactions of prospective purchasers to the marks at issue. As stated in the past, the Board, although receptive to surveys, does not require them in Board proceedings. See, e.g., *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986). The Board appreciates the significant financial cost

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<sup>9</sup> Even if we had ruled the other way in each of the parties' respective objections to evidence, none of the subject testimony is outcome determinative and, thus, we would reach the same result on the merits.



of surveys and, further, obviously recognizes the limited jurisdictional nature of Board proceedings, wherein only rights to federal registrability, not use, are determined. Thus, the Board does not draw any negative inferences from a party's failure to offer survey evidence in a proceeding before the Board. *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1435-36 (TTAB 1993).

Applicant also argues that an absence of any likelihood of confusion may be presumed by the USPTO's publication of applicant's mark over opposer's registrations. This contention is ill founded. The Board reviews the issue based on the record evidence, most of which was not before the examining attorney during ex parte examination, and the Board is not bound or restricted in any way by the examining attorney's actions. *McDonald's Corp. v. McClain*, 37 USPQ2d 1274, 1277 (TTAB 1995).

Next, it is well settled that a newcomer has both the opportunity and the obligation to avoid confusion. Consequently, a party which knowingly adopts a mark similar to one used by another for the same or closely related goods or services does so at its own peril. All doubt on the issue of likelihood of confusion must be resolved against the newcomer. This is especially the case where the established mark is one that is famous. *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); *Nina*

Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); and Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd., 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985).

Although we have resolved any doubt in favor of opposer, so as to be clear, we do not find any bad faith adoption by applicant. Indeed, as indicated above, applicant acted at its own peril in adopting a mark virtually identical to opposer's mark that was disclosed in a trademark search report. The record evidence is not of the caliber, however, upon which to base a finding of a bad faith adoption by applicant.

As a final point, applicant, in its brief, maintains that opposer's inaction, following the alleged instances of actual confusion, establishes laches. As pointed out by opposer, however, laches is not a viable defense in an opposition proceeding inasmuch as the delay is based on the time running from knowledge of the application for registration rather than from knowledge of use. National Cable Television Association v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

### **Conclusion**

We have carefully considered all of the evidence pertaining to the relevant du Pont factors, as well as all of the parties' arguments with respect thereto (including

any arguments not specifically discussed in this opinion), and we conclude that opposer has proved its Section 2(d) ground of opposition. Given the fame of opposer's COVERALL mark, the relatedness of the parties' services, and the overlap in trade channels and classes of purchasers, we find that applicant's mark COVER-ALL is essentially identical to opposer's mark COVERALL and is sufficiently similar to each of opposer's other COVERALL marks that confusion is likely.

We conclude that purchasers familiar with opposer's maintenance and cleaning services for commercial offices and buildings under its famous COVERALL mark would be likely to believe, upon encountering applicant's COVER-ALL mark for installation of floor coverings services, that the services originated with or were somehow associated with or sponsored by the same entity.

Having determined that opposer is entitled to prevail in this opposition based upon its Section 2(d) claim of likelihood of confusion, we need not reach the merits of opposer's claim of false suggestion of a connection under Section 2(a). See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989), *aff'd without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990).

Decision: The opposition is sustained on the Section 2(d) claim and registration to applicant is refused.